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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/640,626

08/12/2003

Arra E. Avakian

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08/29/2006

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EXAMINER

PANTOLIANO JR, RICHARD

ART UNIT

PAPER NUMBER

2194

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/640,626	Applicant(s) AVAKIAN ET AL.	
	Examiner Richard Pantoliano Jr	Art Unit 2194	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20030812</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the initial office action for Application# **10/640,626** filed on **12 August 2003**. **Claim 1** is currently pending and has been considered below.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
3. Applicant listed multiple non-patent literature references on page 20 of the specification of the instant application, but neglected to include said references in an Information Disclosure Statement and neglected to provide copies of said references. Applicant should provide copies of all references disclosed in the specification and cite said references on an Information Disclosure Statement to ensure that said references are officially made of record.

Drawings

4. The drawings are objected to because element 64 of Figure 17 is labeled as "DTL", but referenced in the text on page 32, line 15 of the specification as "JTL". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to

the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:
 - a) Page 1 & 45: Applicant listed several copending applications related to the instant application without providing the serial numbers associated with said applications.
 - b) Pages 4-6: Several acronyms are utilized within these pages of the specification without defining said acronyms. Examples of such acronyms are ARM (pg 4, line 10), COM (pg 4, line 28), and JSP (pg 6, line 7).

c) 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

i) Page 6, Line 18 – "JPS" is used instead of "JSP"

ii) Page 11, Line 5 – "debuging" is used instead of "debugging"

ii) Page 23, Line 30 – "VJM" is used instead of "JVM".

d) Page 32, Line 21 – Applicant makes reference to element 48 in Figures 5 & 6. However, there is no element labeled 48 in Figures 5 or 6. It appears as though Applicant intended to reference element 48 in Figures 15 & 16. Appropriate correction is required.

Claim Objections

6. **Claim 1** is objected to because the third limitation, "...providing an interface, through the inserted..." should read "...providing an interface, through **which** the inserted..." to be grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

- a) the limitation of providing of an interface by which a method can be selected does not specify to whom the interface is provided; and
- b) the limitation of providing of an interface through which the inserted method can pass information about the method does not specify to whom the interface is provided.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

10. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Angel et al. (US Pat: 6,314,558). Angel et al. disclose the method of instrumenting a function of a class by modifying bytecode, comprising:

- a) providing an interface by which the method can be selected (*Col 3, Lines 16-33*) (*The user can select the class and methods for which new bytecode will be added on method entry, exit, call or a throw event*);
- b) inserting bytecodes that will be executed when the selected method is called (*Col 3, Lines 16-33*); and
- c) providing an interface, through which the inserted bytecodes can pass information about the method (*Col 3, Lines 34-47*)(*The message buffer allows for*

information about the modified method to be passed to the environment to allow for display to the user).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a) Alcorn (US Pat: 6,298,475) discloses a method for making methods "dippable", thereby allowing for the insertion of "dips" (new pieces of bytecode) into the already present bytecode;
- b) Berry et al. (US Pat: 6,026,237) discloses a system for dynamic modification of class files by breaking said class files into constituent components and adding to, deleting from, or modifying the bytecode, as necessary;
- c) Hamby et al. (US Pat: 5,848,274) discloses an incremental bytecode compiler that allows for the incremental building of a class file and the addition of new bytecode while the class file is being executed;

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Pantoliano Jr whose telephone number is (571) 270-1049. The examiner can normally be reached on Monday-Thursday, 8am - 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RP

RP
8/23/06


James W. Myhre
Supervisory Patent Examiner